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Examiner:	Daniel Lastra
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Title:	Self Service Terminal

CERTIFICATE OF MAILING

I certify that this document is addressed to Mail Stop AF, Commissioner of Patents, PO Box 1450, Alexandria, VA 22313-1450, and will be deposited with the U.S. Postal Service, first class postage prepaid, on October 22, 2007.

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REPLY BRIEF

References herein to Drummond are to Drummond 888, consistent with the Answer.

GENERAL COMMENT

The Answer, and the Final Office Action, repeatedly assert that the advertising which is displayed at ATMs in Drummond should be censored for content, to avoid giving offense to customers. This assertion is used as a teaching in the obviousness rejections.

Appellant submits that a moment's reflection will show that this assertion is untenable.

Drummond states that a "profile applet," running at an ATM, fetches data from web sites, and presents the data at the ATM.

That data can include advertising. (Paragraph 116.) Other material may be displayed at the ATM, such as

-- instructions for the user (paragraphs 88, 89, 91);

-- "Incentives, premiums, additional transaction options or advertising information" (paragraph 115);

-- exchange rate information (paragraph 165); and

-- differently presented material, at ATMs of different banks (eg, paragraph 150.)

If Drummond is to censor the advertising for offensiveness, then Drummond must assign one or more human employees the task of doing that. But he does not discuss that. And that is expensive.

Further, such a task is probably impossible, because, as stated above, Drummond's "profile applet" fetches the advertising from web sites. The content of those web sites is beyond the control of Drummond.

Further still, such a task would seem ridiculous, not only because the content is out of Drummond's control, but also because the content can change daily. The human employees would need to constantly monitor hundreds of web sites, to assure that they contained no offensive material.

In addition, an interpretation that such censoring exists in Drummond is inconsistent. As stated above, Drummond fetches other materials from web sites besides advertising. Why should the advertising be censored, and not the other materials ?

The Answer cites Drummond's paragraph 151 for the proposition of this censorship. However, that paragraph clearly refers to preventing the browser from reaching dangerous web sites, which could infect the ATM with a virus. That paragraph has no relevance to censoring advertising which would be offensive to Drummond's customers.

Therefore, Appellant submits that the attribution of a desire in Drummond to prevent offensive advertising from being displayed to customers is completely unsupported.

-- Drummond does not discuss it.

-- It would be expensive.

-- It is not clear that it could succeed.

Consequently, the rationale for combining the references is invalid, because it depends on such an attribution.

SPECIFIC REPLIES

Answer, Pages 1 - 7

This section of the Answer repeats material from previous Office Actions. No response is required. Nothing in this section is thereby admitted.

Answer, Pages 8 - 10

The Answer asserts that the Drummond reference is entitled to the earlier filing date of one or more provisional applications, and that those provisional applications precede Appellant's available filing dates.

In response, Appellant points out that the Answer's assertion is technically incorrect. Drummond is entitled to the earlier filing date **only for common content in the Drummond reference and the earlier provisional**.

The common content has not been shown in the earlier provisionals.

The Answer (page 10, line 5 et seq.) apparently asserts that Appellant is required to rebut the Examiner's unsupported assertion that the necessary content of Drummond is present in the provisional(s). That is not correct.

The PTO is required to show the claim elements in prior art having appropriate dates of availability.

Answer, Page 10, Last Paragraph

The Answer is distorting Appellant's argument, by oversimplification.

Appellant is not merely pointing out that no third party is present in Drummond.

Appellant is also pointing out that, because of that absence,

the same party in Drummond would perform both Recitations 1 and 2 of claim 27 (if that performance were found in Drummond). That same party is the owner of the web site.

Claim 27 requires two parties.

This fact is not altered by the Answer's resort to paragraph 116 of Drummond. That paragraph states that a "profile applet" in Drummond's ATM, which a customer is visiting, can fetch materials, such as advertising, from web sites. But the "profile applet" still controls what materials are fetched. There is no "third party."

Further, Drummond's paragraph 116 simply has no relevance to the claim. Paragraph 116 states that an ATM fetches advertising from servers. The claim does not state that.

Further still, the relevant issue is not whether a "third party" is present, but whether the claim recitations are found in the reference. As the Brief states, claim 27 recites:

> 1) providing a database for storing advertisements ("Recitation 1") and
>
> 2) allowing a "customer" access to the database, to store advertisements in the database ("Recitation 2").

The other materials, such as advertising, in paragraph 116 of Drummond are not stored by a "customer."

Therefore, the two claimed processes, performed by two

parties, are not shown in Drummond.

Answer, Page 11, First Full Paragraph

The Answer at this location expressly admits that Drummond does not show the claim.

The Answer states:

> The Examiner Answers that Drummond teaches that the "customer" accessing the ATM is different from the advertisers that provides the advertisements to the ATM terminals . . .

That is directly contrary to claim 27. Claim 27 states that the customer stores advertisements in the database.

Answer, Page 11, Last Paragraph

The Answer is re-defining the term "customer." That is not allowed.

The claimed "customer" is a customer of the ATM. The claim language is "ATM customer."

The Answer asserts that the advertisers in Drummond are ATM customers. That makes no sense.

Further, the Answer asserts that the temporary display of advertisements at the ATM in Drummond corresponds to the claimed storage of the advertisements. That cannot be so. As soon as the customer leaves, the advertisements disappear. There is no

storage.

Further still, the claim states that the advertisements are stored in a "database." No "database" has been shown in the ATM in Drummond, where the advertising is supposedly "stored."

Answer, Page 12, First Full Paragraph

The Answer asserts that the Brief is relying on a limitation not found in claim 27. The Brief states, on page 17:

> Further, the claim states that the advertisement is stored in a database entry "associated with the ATM." That is not seen in Drummond. (As to this recitation, the Specification states that each ATM has specific advertisements associated with it. Page 3, lines 3 - 5.) .

The Answer asserts that the parenthetical phrase in this statement is not contained in the claim.

Appellant points out that the parenthetical gives a specific example of the general claim language, and thus defines the latter, by example. The Specification is allowed to provide definitions for claim terminology.

From another point of view, the parenthetical is a necessary consequence of the claim language.

That is, the claim states that the advertisement in question is stored in a database entry associated with the ATM. Thus, if one locates the ATM (more precisely, the ATM's entry) in the

database, one necessarily finds the advertisement associated with that ATM.

Consequently, the parenthetical follows from the claim language, and is thus contained in, or implied by, the claim language.

Answer, Page 12, Last Paragraph

The Brief pointed out that Drummond teaches a "wide range" of materials, and that Gupta teaches suppressing certain advertising.

Now the Answer cites Drummond's paragraph 151 as teaching that access to certain web sites should be restricted.

If so, then Drummond is self-contradictory. On the one hand, he suggests wide access, and on the other hand he suggests restriction of access to web sites.

The Answer must provide a teaching for selecting one suggestion over the other. That has not been done.

Further, the issue is whether the teaching used by the Final Office Action for combining the references is valid. That teaching is that "one desires to avoid offensive advertising at a public ATM." so that the references should be combined, to attain that goal.

However, insofar as both references teach restricting access to materials (Gupta teaches suppression of certain advertising and Drummond's paragraph 151 supposedly teaches restricting access to

certain web sites), there is no need to combine the references to attain the PTO's goal of avoiding offensive advertising. Either reference, by itself, can attain that goal.

Further still, as explained above, Drummond's paragraph 151 has nothing to do with suppressing advertising. That paragraph suggests restricting access to dangerous web sites, for security reasons.

Answer, Page 13, First Full Paragraph

The PTO has still not shown the two "means" in a reference having a proper date. The PTO has not shown the "means" in the provisional application upon which reliance is placed.

Further, Appellant points out that section 112 states:

> An element in a claim for a combination may be expressed as a **means** . . . for performing a specified function without the recital of structure, material, or acts in support thereof,
>
> and
>
> **such claim shall be construed to cover the corresponding structure, material, . . . in the specification and equivalents thereof.**

The Answer has not shown the "corresponding structure" nor "equivalents thereof" in Drummond.

Answer, Page 13, Second Full Paragraph

The Brief addresses the Answer.

Further, even if the Answer is correct, the claim language is still not found in the reference. The Answer merely asserts that

1) Drummond uses a browser to display advertisements and

2) advertisements are delivered to an ATM at various times.

That fails to show the claim.

Appellant repeats a sentence from the Brief:

> This claim states, speaking generally, that the ATM contains a browser which allocates screen space **at predetermined "allocation times."**

The Answer has failed to show a browser which does this.

Answer, Page 13, Last Paragraph

The PTO has still not shown the two "means" in a reference having a proper date. The PTO has not shown the "means" in the provisional application in question.

Answer, Page 14, First Paragraph

The Brief addresses this paragraph.

Answer, Page 14, Second Paragraph

The Answer points to paragraph 116 in Drummond, to show the

"server" of claim 22. However, paragraph 116 merely refers to a "profile applet" which fetches data from web sites. That "profile applet" runs on Drummond's ATM. The ATM is not a "server."

Therefore, no "server interconnected to the ATM and for accessing the advertisement database in response to a request from the ATM" as claimed has been shown in Drummond.

Further, the claim states that the "server" contacts an "advertisement database" and transmits an advertisement to an ATM. That is impossible under the Answer's assertion.

How does the "profile applet" qualify as a "server" which transmits advertising to the ATM, when the "profile applet" is running on the very ATM to which it fetches the advertising ?

Answer, Page 14, Third Paragraph

Claim 26 recites:

> means for connecting to a second server to retrieve an authorized advertisement associated with the ATM.

No retrieval of an "authorized advertisement associated with the ATM" has been shown in Drummond.

Answer, Page 14, Last Paragraph

For simplicity, the Brief showed that a few elements of claim

27 have not been shown in the reference. That, by itself, would have been sufficient to preclude rejection. Now the Answer attempts to show those few elements to be present in the reference.

In response, this Reply will show that other elements of the claim have not been shown.

Claim 27 states that an "ATM customer" gains access to a database, and transmits advertising to the database. That has not been shown.

Further, claim 27 states that the advertisement transmitted is "screened." The screening which the Answer cites in Drummond does not correspond to the claimed screening. For example, the Answer states that Drummond shows "screening software to prevent . . . sending messages to particular addresses." That does not correspond to the claimed "screening."

Further still, claim 27 recites "storing the screened advertisement in a database entry associated with the ATM." That has not been shown in Drummond.

Answer, Page 15, First Full Paragraph

The Examiner now relies on paragraph 88 of Drummond to show claim 30.

This paragraph merely states that a server delivers documents for display on ATMs, and that different ATMs may receive different

documents.

That does not show the first three "means" of claim 30.

Answer, Page 15, Last Paragraph

The Answer asserts that Drummond teaches limiting the addresses which the browser may access. As explained above, this contradicts the suggestion of Drummond that access to a "wider variety" of materials be granted. (Paragraphs 20 and 21.)

Thus, Drummond contains contrary suggestions. A teaching is required for selecting one over the other, and none has been given.

The conclusion (last sentence of the Answer's paragraph) does not follow logically from the preceding discussion in the Answer. The preceding discussion describes what the references supposedly do, and do not, teach. The conclusion does not follow from that discussion, as a matter of logic.

Further, the conclusion is that it is obvious to combine the references to "allow/deny unacceptable advertisements to be displayed in the ATM terminals." As explained above, according to the Answer, both references teach restricting advertising. Thus, there is no reason to combine them to attain the goal of restricting advertising.

And even if they did not both teach that, Gupta teaches restriction of advertising (but not at an ATM). If you want such

restriction, then use Gupta alone.

Answer, Page 16, First Paragraph.

The Answer fails to rebut the Brief's arguments that Drummond is rendered inoperative.

Further, the Answer now adds additional prior art, in the form of "well known" art. Appellant requests that this "well known" art be justified, partly because Appellant submits that it is dubious. (See MPEP § 2144.03.) It is dubious because, in essence, it merely asserts that some party, at some time, refused advertising. Even if true, such a fact leads nowhere, for 103 purposes.

Further still, even if some web sites refuse some advertising, that does not rebut the Brief's argument that Gupta renders Drummond inoperative.

Answer, Page 16, Second Paragraph

The Brief shows one inconsistency between the references. Thus, the PTO must set forth a teaching which overcomes that inconsistency. That has not been done.

Further, the Answer's citation of Drummond's paragraph 151 does not overcome the inconsistency. That paragraph limits access to web sites for security reasons. For example, Appellant points out that certain web sites are known to infect a visitor's

computer with viruses. Drummond is talking about such web sites.

Drummond's restricting access to such web sites has no relevance to restricting advertising.

Answer, Page 16, Last Paragraph

The Answer reads Drummond's paragraph 151 as restricting the type of advertising which is presented to a customer.

Appellant submits that this is not reasonable. As explained above, that paragraph suggests measures such as preventing the browser from reaching a dangerous web site.

This conclusion is supported by Drummond's other statements that he wants to offer a wide range of access to his customer. The wide range is inconsistent with the concept of restriction.

This paragraph of the Answer concludes with the assertion that Drummond should be combined with Gupta for the purpose of screening Drummond's advertising, to prevent offense to customers. This assertion has been addressed in the Brief.

In addition, Appellant points out that, again, if the purpose of blocking offensive advertising is the goal, then Gupta, by himself, suggests that. There is no reason for the addition of Drummond.

Answer, Page 17, Last Paragraph

The Answer is attributing teachings to Drummond which are not

present. The Answer cites Drummond's paragraph 88 as teaching "controlling advertisements to be displayed." But that paragraph does not mention "control" at all. It merely discusses advertising at ATMs.

Then, the Answer, having conjured the concept of "control" in Drummond, leaps to the conclusion that Drummond's control should extend to suppression of some advertising, as in Gupta.

Drummond's paragraph 88 merely discusses advertising at ATMs. It has no relevance to Gupta's suppression of advertising, and does not suggest suppression of advertising.

The final sentence of the Answer's paragraph is not relevant. References are not "combinable." That is not a defined term.

And they do not become "combinable" because an argument of an Appellant is supposedly overcome.

The issue is whether a teaching is present. A teaching is required for combining the references. That teaching must be found in the prior art, or knowledge shown to be in possession of one skilled in the art. As to the latter, evidence is required.

Answer, Page 18, First Full Paragraph

The Answer asserts that the "holder" of the "goal" of avoiding offense to customers is the ATM operator. That is, Answer asserts that the ATM operator wishes to avoid offending customers.

That is a fabrication by the Examiner. That is not prior art.

That cannot be used.

Therefore, this goal of ATM operators has not been shown in the prior art.

The Examiner is not allowed to manufacture goals and motives of parties who may be mentioned in references.

Further, this "goal" is highly suspect. The Answer mentions avoidance of pornographic advertising as a goal of Gupta, because it is offensive. However, Appellant submits that a studio which manufactures X-rated movies would have no problem with pornographic advertising at ATMs on the premises of the studio. Who would be offended ?

Thus, the "goal" of the Answer is dubious.

Answer, Page 18, Second Full Paragraph

The Brief states:

> Therefore, Appellant submits that, while Gupta in the combined references may suggest suppression of certain advertising, no teaching is present which explains what criteria are used to **accept** advertising.

The Answer has not provided such criteria. The Answer has merely asserted that Gupta may accept "book advertisements." But that is not a criterion for acceptance. Would Gupta accept advertisements for X-rated books ? No.

Further, at best, the Answer, if accurate, merely rebuts a

specific example of Appellant's. But the larger proposition is this: The PTO has not shown an effective system which (1) reduces or eliminates offense to customers while (2) presenting effective advertising. Thus, no expectation of success, as required, has been shown.

Answer, Page 18, Last Paragraph

Drummond does not state that the browser can be controlled by the customer, as in surfing the web.

Drummond uses the pre-packaged capabilities of a browser, which allow Drummond to fetch data from web sites, without the need for Drummond to write the code to do that.

This is a matter of interpretation. Does Drummond allow his customer to use the browser to surf the web, or not ?

In point of fact, the browser in Drummond is "made available" to the software in Drummond's system, which controls the browser. The **output** (ie, image displayed) of the browser may be shown to the customer. But that does not mean that the browser itself is made available to the customer.

By analogy, if I see a movie star drive by in a Rolls Royce, is the Rolls Royce "made available" to me ? No. One reason is that I have no control over it.

Answer, Page 19, First Paragraph

Paragraph 121 of Drummond does not show the claimed "applying a charge to each advertisement based on the number of accesses [to the database]."

Further, under the claim, "accesses" are made to the "database," to which a customer previously transmitted advertisements. That "database," and those advertisements, are not present in Drummond.

Answer, Page 19, Second Paragraph

The Brief addresses this paragraph.

Answer, Page 19, Last Paragraph

The Brief addresses this paragraph.

Appellant points out that section 112 states that the claims are part of the Specification.

Further, the issue is whether the language of the claims is found in the references. The Brief shows that the language is not, and the Answer does not refute this.

Further still, Appellant points out that the Answer mis-interprets the passage in the Brief. In the phrase "single entity and its agents," the term "agents" means entities which are controlled by the "entity." Appellant has no need to resort to the Specification to explain this statement.

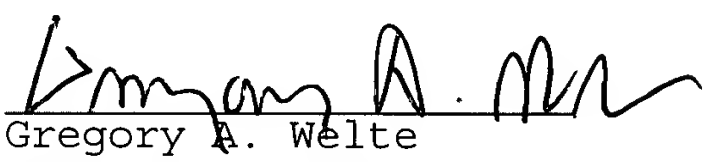
To repeat: in the phrase "single entity and its agents" the

word "its" means that the "agents" belong to the "single entity." "Its" is a possessive pronoun, and its referent is "single entity."

Since they are "agents" possessed by the "single entity," they are controlled by that entity.

This is a question of English grammar, regarding whether one phrase is implied by, or contained in, another.

Respectfully submitted,



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